

08CL5989-2

REMARKS

Claims 1-12 and 14-17 are pending in the present application. Claim 3 has been amended, leaving Claims 1 - 12 and 14 - 17 for consideration upon entry of the present Amendment. No new matter has been introduced by these amendments.

Applicants call the attention of the Examiner to the Declaration pursuant to 37 C.F.R. §1.132, filed concurrently with the present response, which presents comparative data. Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claim 3 stands rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in relevant art that the inventors, at the time the applications was filed, had possession of the claimed invention. In particular, the Examiner states "[t]hat there is no mention of sodium tetraethyl ammonium perfluoromethylbutane sulphonate, or any of the other compounds listed in the claim, in the specification" (Paper 13, page 2). Applicants have amended Claim 3 to comply with the requirements of §112, first paragraph. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-12 and 14-17 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over U.S. Patent No. 5,663,280 to Ogoe et al. ("Ogoe '280"), U.S. Patent No. 5,041,479 to Ogoe et al. ("Ogoe '479"), or U.S. Patent No. 5,339,600 to Buysch et al. ("Buysch"), in view of U.S. Patent No. 4,130,530 to Mark et al. ("Mark") or U.S. Patent No. 6,353,046 to Rosenquist et al. ("Rosenquist") (Paper 13 , page 2).

In making the rejection the Examiner has stated that "[t]he declaration by Dr. Singh has no probative value, because the impact strength of the polycarbonate with no siloxane added is not known. Furthermore, Rosenquist et al. provides the perfect motivation to add the

08CL5989-2

cyclic siloxane to the polycarbonate compositions of the primary reference. Were Applicants to show that the secondary reference and the instant application had been commonly owned at the time the instant application was filed, the rejection would be obviated" (Paper 13, page 3).

Applicants would like to accept the Examiner's offer of patentability of the instant application and therefore have attached documents showing that one of the secondary references i.e., Rosenquist was commonly co-owned at the time the instant application was filed. Attached herewith are copies of the assignment and the recordation form for U.S. Patent Serial No. 09/560,770 (now U.S. Patent 6,353,046 to Rosenquist) wherein an assignment was made to the General Electric Company on the May 16, 2000. Since the present application was filed on December 12, 2000, both, the secondary reference as well as the instant application were commonly owned at the time the instant application was filed and therefore the Applicants request a withdrawal of the rejection over Ogoe '280, Ogoe '479 or Buysch in view of Rosenquist.

However, the Applicants would like to point out that the other secondary reference i.e., Mark, was filed in 1977 and therefore expired prior to the filing of the present application. As a result, Applicants are not able to show that Mark was co-owned by the same entity at the time the present Application was filed.

In order to overcome the rejection over Ogoe '280, Ogoe '479 or Buysch in view of Mark, the Applicants have therefore filed another declaration from the Applicants to demonstrate that the motivation for adding the cyclic siloxane to the polycarbonate resin containing the flame retardant salt, is not to improve impact strength as contended by the Examiner in Paper 7, page 4. In particular the new declaration is directed at the Examiner's contention that Dr. Singh's Declaration lacks probative value since the impact strength of the polycarbonate with no siloxane is added is not known. In short, the Applicants disagree with the rejection on the grounds that the Examiner has not made a prima facie case of obviousness over Ogoe '280, Ogoe '479 or Buysch in view of Mark.

08CL5989-2

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Ogoe '280 teaches a carbonate polymer composition comprising a carbonate polymer, a low volatility aromatic phosphate ester compound, and optionally an alkali metal salt having a pH of at least 7 (see Abstract). While Ogoe '280 teaches the optional use of alkali metal salts in conjunction with aromatic phosphate ester compounds in polycarbonate resins, it does not teach polycarbonate resins comprising the flame retardant salts and the cyclic siloxane as presently claimed. Since Ogoe '280 does not teach utilizing the claimed cyclic siloxane, it does not teach all elements of the composition.

Ogoe '479 discloses making a concentrate by pelletizing a carbonate polymer comprising one or more additives selected from the group consisting of a metal salt, a halogenated aromatic compound, a metal salt of an inorganic compound, a free aromatic sulfimide and a fibril forming polytetrafluoroethylene (see Claim 1). Ogoe '479, like Ogoe '280 does not teach blending a cyclic siloxane with a concentrate comprising a polycarbonate resin and a flame retardant salt, as presently claimed. Since Ogoe '479 does not teach the use of a cyclic siloxane in the claimed flame resistant polycarbonate composition, it too does not teach all elements of the present claims.

Buysch teaches blends of polycarbonate with triphenylphosphane sulphonates and optionally fluorinated polyolefins (see Abstract). Buysch, like Ogoe '479 and Ogoe '280 does not teach a method for making a flame resistant composition wherein a flame retardant salt and cyclic siloxane are blended with a polycarbonate resin as presently claimed. In

08CL5989-2

particular, Buysch does not teach the addition of a cyclic siloxane to the claimed concentrate, and therefore does not teach all elements of the present claims.

Mark teaches a plasticized polycarbonate composition comprising high molecular weight aromatic carbonate polymer and a minor amount of a cyclic siloxane plasticizer (See Abstract). Mark teaches that the cyclic siloxane plasticizers are added to polycarbonates to maintain impact strength and improve melt flow (see Example I). Mark does not teach the use of flame retardant salts in conjunction with a polycarbonate resin and therefore does not teach all elements of the claims.

With reference to the enclosed declaration, two sets of experiments were conducted to demonstrate that the addition of cyclic siloxane to a polycarbonate resin containing a flame retardant salt does not improve impact properties as maintained by the Examiner. The compositions for these two sets of experiments are shown in Tables 1 and 2 of the attached declaration. Table 1 contains six compositions containing polycarbonate resin. Samples 1, 2 and 5 each possess 0.05 parts per hundred (phr) of the flame retardant salt. Samples 1 and 5 are identical in composition each having 0.1 phr of the cyclic siloxane while Sample 2 contains 0.2 phr of the cyclic siloxane in addition to the flame retardant salt. Sample 3 contains only 0.1 phr of the flame retardant salt, while Sample 4 contains 0.1 phr of the flame retardant salt in addition to 0.2 phr of the cyclic siloxane. Sample 6 contains only 0.1 phr of the cyclic siloxane. Impact properties were measured for all samples.

As may be seen from Table 1, the impact strength increases only slightly from approximately 15.69 and 15.57 ft-lbs/inch for Samples 1 and 5 respectively to 15.87 ft-lbs/inch for Sample 2, which is within the limits of statistical variation when the standard deviations shown in Table 1 is taken into account. Similarly the impact strength of Sample 3, may be compared with Sample 4 (since they each contain 0.1 phr of the flame retardant salt). From the impact strength results it can be seen that there is practically no variation in the impact strength results for Samples 3 or 4. All the impact strength results are within the limits of statistical variation. Similarly, Sample 6, which contains only 0.1 phr of the cyclic siloxane also shows similar impact properties to Samples 3 and 4. Thus it can be seen that a polycarbonate resin containing 0.1 phr of flame retardant salt or 0.1 phr of cyclic siloxane do

08CL5989-2

not possess significantly different impact strengths. This clearly shows that the addition of the flame retardant salt does not degrade impact strength in as much as the cyclic siloxane does not improve impact strength as claimed by the Examiner.

Similarly, the experiments shown in Table 2 were further conducted to prove that the addition of only the flame retardant salt to the polycarbonate resin does not in any way alter the impact properties of the polycarbonate resin. From the table it may be seen that the increasing the quantity of the flame retardant salt from 0.0 to 0.1 phr does not reduce the impact strength of the polycarbonate resin. Thus, once again it can be clearly seen that the addition of the flame retardant salt to the polycarbonate resin does not degrade the impact strength and therefore the motivation for adding the cyclic siloxane is not to improve the impact properties of the polycarbonate resin as maintained by the Examiner. In view of the fact that there is no improvement in impact strength by the addition of the cyclic siloxane, there is no motivation to combine Ogoe '280, Ogoe '479 or Buysch in view of Mark as contended by the Examiner. In addition, as shown in Rosenquist and discussed in the response to the Office Action (Paper 7), the addition of the cyclic siloxane to the polycarbonate resin containing the flame retardant salt improves the flame retardancy in an unexpected manner, since the cyclic siloxane by itself is not a flame retardant additive. The Applicants therefore request a withdrawal of the rejection and an allowance of the claims.

In conclusion, the rejection of the claimed invention over Ogoe '280, Ogoe '479 or Buysch in view of Rosenquist cannot be maintained since the secondary reference was commonly owned at the time of filing of the present application. Documents pertaining to the common ownership are attached to this document. Applicants also request a withdrawal of the rejection over Ogoe '280, Ogoe '479 or Buysch in view of Mark since there is no motivation to combine the references and further there is no expectation of success.

Information Disclosure Statement

The Examiner states that the IDS filed on 8/19/02 was not considered because the references were not found in the file. Accordingly, Applicants submitted a Request to Consider the References via First Class mail to the U.S.P.T.O. on December 13, 2002.

08CL5989-2

In light of the foregoing amendments and remarks, reconsideration by the Examiner is respectfully requested. It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No.07-0862 maintained by Applicants' attorneys.

Respectfully submitted,

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08CL5989-2

VERSION WITH MARKINGS TO SHOW CHANGES MADE

A marked-up version of Claim 3 follows:

Claim 3. (Twice amended/marked-up) The method of claim 1, wherein the flame retardant salt is sodium ~~tetraethyl ammonium~~ perfluoromethylbutane sulphonate, potassium ~~tetraethyl ammonium~~ perfluoromethylbutane sulphonate, tetraethyl ammonium perfluoromethylbutane sulphonate, sodium ~~tetraethyl ammonium~~ perfluoromethane sulphonate, potassium ~~tetraethyl ammonium~~ perfluoromethane sulphonate, tetraethyl ammonium perfluoromethane sulphonate, sodium ~~tetraethyl ammonium~~ perfluoroethane sulphonate, potassium ~~tetraethyl ammonium~~ perfluoroethane sulphonate, tetraethyl ammonium perfluoroethane sulphonate, sodium ~~tetraethyl ammonium~~ perfluoropropane sulphonate, potassium ~~tetraethyl ammonium~~ perfluoropropane sulphonate, tetraethyl ammonium perfluoropropane sulphonate, sodium ~~tetraethyl ammonium~~ perfluorohexane sulphonate, potassium ~~tetraethyl ammonium~~ perfluorohexane sulphonate, tetraethyl ammonium perfluorohexane sulphonate, sodium ~~tetraethyl ammonium~~ perfluoroheptane sulphonate, potassium ~~tetraethyl ammonium~~ perfluoroheptane sulphonate, tetraethyl ammonium perfluoroheptane sulphonate, sodium ~~tetraethyl ammonium~~ perfluorooctane sulphonate, potassium ~~tetraethyl ammonium~~ perfluorooctane sulphonate, tetraethyl ammonium perfluorooctane sulphonate, sodium ~~tetraethyl ammonium~~ perfluorobutane sulfonate, potassium ~~tetraethyl ammonium~~ perfluorobutane sulfonate, tetraethyl ammonium perfluorobutane, sodium ~~tetraethyl ammonium~~ diphenylsulfone sulphonate, potassium ~~tetraethyl ammonium~~ diphenylsulfone sulphonate, tetraethyl ammonium diphenylsulfone sulphonate, or mixtures comprising at least one of the foregoing flame retardant salts.